

This Page Is Inserted by IFW Operations
and is not a part of the Official Record

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images may include (but are not limited to):

- BLACK BORDERS
- TEXT CUT OFF AT TOP, BOTTOM OR SIDES
- FADED TEXT
- ILLEGIBLE TEXT
- SKEWED/SLANTED IMAGES
- COLORED PHOTOS
- BLACK OR VERY BLACK AND WHITE DARK PHOTOS
- GRAY SCALE DOCUMENTS

IMAGES ARE BEST AVAILABLE COPY.

**As rescanning documents *will not* correct images,
please do not report the images to the
Image Problem Mailbox.**

Atty Docket No. 017516-006810US

PTO FAX NO.: 703/ 746-9195

ATTENTION: JCWS
TELEPHONE NO.: 703-

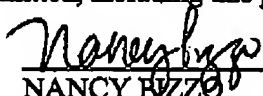
Group Art Unit 3732

**OFFICIAL COMMUNICATION
FOR THE PERSONAL ATTENTION OF****Attn: JCWS****CERTIFICATION OF FACSIMILE TRANSMISSION**

I hereby certify that the following document(s) in re Application of CRAIG R. GERBI et al.,
Application No. 10/624,848, filed July 21, 2003
for *Tool Guide and Method for Introducing an End Effector
to a Surgical Site in Minimally Invasive Surgery*
is being facsimile transmitted to the Patent and Trademark Office on the date shown below.

Number of pages being transmitted, including this page: 9

Dated: January 16, 2004


NANCY RIZZODocument(s) Attached

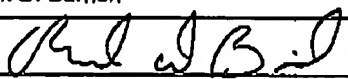
1. TRANSMITTAL FORM (1 pg)
2. REQUEST FOR CORRECTED FILING RECEIPT (3 pgs)
3. COPY OF UPDATED FILING RECEIPT (2 pgs)
4. COPY OF NOTICE OF OMITTED ITEM(S) (2 pgs)

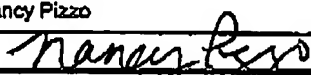
**PLEASE CONFIRM RECEIPT OF THIS PAPER BY
RETURN FACSIMILE AT (415) 576-0300**

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, 8th Floor
San Francisco, CA 94111-3834
Tel: 650-326-2400
Fax: 650-326-2422

50120956 v1

PTO/SB/21 (08-03)

TRANSMITTAL FORM (to be used for all correspondence after initial filing)		Application Number	10/624,848
		Filing Date	July 21, 2003
		First Named Inventor	GERBI, CRAIG RICHARD
		Art Unit	3732
		Examiner Name	
Total Number of Pages in This Submission		Attorney Docket Number	017516-006810US
ENCLOSURES (Check all that apply)			
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s)	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Request for Corrected Filing Receipt Copy of Notice of Omitted Item(s) . . . Return Postcard	
Remarks		The Commissioner is authorized to charge any additional fees to Deposit Account 20-1430.	
SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm or Individual	Townsend and Townsend and Crew LLP Mark D. Barrish		Reg. No. 36,443
Signature			
Date	01/16/2004		

CERTIFICATE OF MAILING			
I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office - JCWS at:			
Fax No. (703) 746-9195			
Typed or printed name	Nancy Pizzo		
Signature		Date	01/16/2004

60120970 v1

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, to JCWS
Fax No. 1-703-746-9195 on January 16, 2004.

TOWNSEND and TOWNSEND and CREW LLP

By: Nancy Pizzo
NANCY PIZZO

PATENT

Atty. Docket No.: 017516-006810US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Craig Richard Gerbi et al.

Application No.: 10/624,848

Filed: May 31, 2001

For: Tool Guide and Method for Introducing an
End Effector to a Surgical Site in
Minimally Invasive Surgery

Confirmation No.: 6559

Examiner:

Art Unit: 3732

**REQUEST FOR CORRECTED
FILING RECEIPT**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request that the Filing Receipt of the subject application be corrected to acknowledge the actual filing date of July 21, 2003.

On October 24, 2003, the U.S. Patent Office (USPTO) mailed a *Notice of Omitted Items in a Nonprovisional Application* (hereinafter *Notice*), for the subject case. That Notice indicated that Fig. 11 described in the specification had not been received by the USPTO with the subject filing. The *Notice* presented Applicants with three options:

- I. "Should Applicant contend that the above-noted omitted item was in fact deposited. . ."
- II. "Should Applicant desire to supply the omitted item and accept the date such omitted item was filed in the USPTO as the filing date. . ."

FREDERIC H. MOLL et al.
Application No.: 10/624,848
Request for Corrected Filing Receipt

PATENT

III. "The failure to file a Petition (and petition fee) under above options I) or II), within **TWO MONTHS** of the date of this Notice . . . will be treated as constructive acceptance by the Applicant of the application as deposited in the USPTO."

Applicants did not file a petition or petition fee under options I) or II) of the Notice, and instead filed a Preliminary Amendment. The Preliminary Amendment noted, under the heading *Response to the Notice of Omitted Item in a Nonprovisional Application*, that "Applicants elect option III) of the *Notice* mailed on October 24, 2003 for the subject application." Hence, Applicants explicitly accepted the application (with its original filing date of July 21, 2003) as the application was received by the USPTO. Fortunately, purportedly omitted Fig. 11 of the application as received by the USPTO was the same as Fig. 11 from the parent application 09/872,750, of which the present application is a divisional. Hence, the Preliminary Amendment also added Fig. 11 from the parent application, which had been incorporated by reference into the subject application on page 1, lines 6-8. Therefore, Applicants accepted the application as it was filed in July, and the application as filed effectively included all the desired subject matter.

Despite expressly electing option III) and also constructively electing option III) (through not filing the petition under options I) or II)), Applicants have received an *Updated Filing Receipt* mailed from the USPTO on December 10, 2003, a copy of which is attached. The *Updated Filing Receipt* indicates that the filing date for the subject application was November 10, 2003. As this is contrary to Applicant's election of option III) from the *Notice* and as the originally filed application effectively included all the desired subject, Applicants respectfully request that the enclosed filing receipt be corrected to reflect the actual filing date of July 21, 2003.

FREDERIC H. MOLL et al.
Application No.: 10/624,848
Request for Corrected Filing Receipt

PATENT

If required, the Asst. Commissioner of Patents is authorized to deduct any required fee for correction of the Filing Receipt from Deposit Account No. 20-1430. A duplicate copy of this Request is attached.

Respectfully submitted,



Mark D. Barrish
Reg. No. 36,443

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, 8th Floor
San Francisco, California 94111-3834
Tel: (415) 576-0200 / Fax: (415) 576-0300
MDB:nap
23319820 v1



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1420
Alexandria, Virginia 22313-1420
www.uspto.gov

APPL NO.	FILING OR 371 (c) DATE	ART UNIT	FILE FEE REC'D	ATTY. DOCKET NO	DRAWINGS	TOT CLMS	IND CLMS
10/624,848	11/10/2003	3739	534	017516-006810US	10	33	4

20350
TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

CONFIRMATION NO. 6559

UPDATED FILING RECEIPT



0000000011457595

Date Mailed: 12/10/2003

Receipt is acknowledged of this regular Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Filing Receipt Corrections, facsimile number 703-746-9195. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

Applicant(s)

Craig Richard Gerbi, Mountain View, CA;
Daniel T. Wallace, Redwood City, CA;

Assignment For Published Patent Application

Intuitive Surgical, Inc., Sunnyvale, CA;

Domestic Priority data as claimed by applicant

This application is a DIV of 09/872,750 05/31/2001 PAT 6,820,173

Foreign Applications

If Required, Foreign Filing License Granted: 10/22/2003

Projected Publication Date: 03/18/2004

Non-Publication Request: No

Early Publication Request: No

** SMALL ENTITY **

Title

Tool guide and method for introducing an end effector to a surgical site in minimally invasive surgery

Preliminary Class
606

**LICENSE FOR FOREIGN FILING UNDER
Title 35, United States Code, Section 184
Title 37, Code of Federal Regulations, 5.11 & 5.15**

GRANTED

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Office of Export Administration, Department of Commerce (15 CFR 370.10 (j)); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

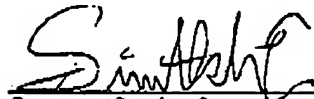
NOT GRANTED

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).

omitted drawing(s), relabel the drawing figures to be numbered consecutively (if necessary), and correct the references in the specification to the drawing figures to correspond with any relabeled drawing figures, is required. A copy of the drawing figures showing the proposed changes in red ink should accompany with any drawing changes. Such amendment and/or correction to the drawing figures, if necessary, should be by way of preliminary amendment submitted prior to the first Office action to avoid delays in the prosecution of the application.

Replies should be mailed to: Mail Stop Missing Parts
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

*A copy of this notice **MUST** be returned with the reply.*



Customer Service Center
Initial Patent Examination Division (703) 308-1202

PART 1.- ATTORNEY/APPLICANT COPY